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09/695,022	10/23/2000	Steven Z. Wu	M-8873 US	3060

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Cameron Kerrigan  
SQUIRE, SANDERS & DEMPSEY L.L.P.  
One Maritime Plaza,  
Suite 300  
San Francisco, CA 94111-3492

EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 12/20/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/695,022

Applicant(s)

WU ET AL.

Examiner

Paul B. Prebille

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-12+20 is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s)        is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on        is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on        is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No.       .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s).
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12 and 20, drawn to the prosthesis, classified in class 623, subclass 1.43.
- II. Claims 13-19, drawn to the method of loading, classified in class 600, subclass 36.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product, as claimed, could be made by a different process of making such as forming the grooves in the prosthesis as the prosthesis is formed by molding or molding the prosthesis around the monofilament to form the groove.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Cameron Kerrigan on December 11, 2001 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12 and 20. Affirmation of this election must be made by applicant in replying to

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this Office action. Claims 13-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Particularly, it does not specify that the claimed invention is an implantable prosthesis and that the prosecuted claims are drawn only to a product and not a method also.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 12 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wu et al (US 6,254,632); see the entire document.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11, 12, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al (US 6,071,305), or alternatively, under 35 USC 103(a) as being unpatentable over Brown et al (US 6,071,305) alone. Brown et al anticipates the claim language where the filament portions are the active agents in carriers (23,25) of Brown; see the whole document, especially Figure 9. The active agent with carrier (23,25) is considered to be a fiber to the extent required by the present claim language.

Alternatively, if one does not consider the active agent with carrier (23, 25) to be fibers, it is the Examiner's position that they are clearly suggestive thereof due to they cylindrical elongate structure. For this reason, Brown et al is considered to at least clearly obviate the presently claimed invention under this interpretation.

With regard to claim 6 specifically, it is noted that the limitation of exposing the body to a laser is a method limitations. For this reason, it is not afforded much patentable weight in that it is product-by-process limitation; see MPEP 2113, which is incorporated herein by reference there. In particular, if the product is not considered to be identical, it is considered to be at least substantially identical to the extent that is it clearly obvious thereover.

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With regard to claim 8, it is noted that collagen, one of the agents of carriers, is a polymer of amino acids as are all proteins. For this reason, the claim language is fully met.

With regard to claim 11, the barrier as claimed is present by the top end of the groove, which converges into a slit. Therefore, the present claim is at least obvious in view of Brown et al, which clearly suggests it.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (US 6,071,305) in view of Fischell et al (US 5,722,984). Brown et al at least obviates the claim language as set forth above and fails to teach the use of a radioactive isotope as claimed. Fischell et al, however, teaches that it was known to use radioactive isotopes in stent devices in order to reduce cell proliferation and restenosis; see the whole document, especially the abstract. Hence, it is the Examiner's position that it would have been obvious to use a radioactive isotope along with or in place of the active agents of Brown et al in order to reduce cell proliferation and restenosis as taught by Fischell et al.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned problem is corrected.

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Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
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